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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Frank F. Loomis, III, DBA Glenn Publishing

Serial Nos. 75/930,465 & 75/930,476

Frank F. Loomis, III, Esq., *pro se*.

William T. Verhosek, Trademark Examining Attorney, Law
Office 114 (Margaret K. Le, Managing Attorney).

Before Hanak, Quinn and Bucher, Administrative Trademark
Judges.

Opinion by Bucher, Administrative Trademark Judge:

Frank F. Loomis, III, seeks registration on the
Principal Register for two designations, MAKEFEELGOOD¹ and
MAKEFEELBAD,² as service marks allegedly used in connection

¹ Application Serial No. 75/930,465, filed on February 14, 2000, is based upon applicant's claim of a *bona fide* intention to use the mark in commerce. In applicant's statement of use filed on January 25, 2001, applicant claimed first use anywhere and first use in commerce as of November 15, 1999.

² Application Serial No. 75/930,476, filed on February 14, 2000, is based upon applicant's claim of a *bona fide* intention to use the mark in commerce. In applicant's statement of use filed on January 25, 2001, applicant claimed first use anywhere and first use in commerce as of November 15, 1999.

with "counseling, namely, offering advice regarding interpersonal skills," in International Class 42.

These cases are now before the Board on appeal from separate final refusals to register the marks in each application. Because the marks, the legal issues, the procedural histories and overall records are closely related in these two appeals, these cases have been consolidated for purposes of this appeal, and the Board has chosen to issue a single opinion.

The Trademark Examining Attorney has refused registration of applicant's marks based upon the ground that this matter does not function as a service mark for applicant's recited counseling services under Sections 1, 2, 3 and 45 of the Trademark Act, 15 U.S.C. §§1051, 1052, 1053 and 1127, and that applicant has failed to submit acceptable specimens demonstrating good service mark usage.

By contrast, applicant states his case as follows:

[MAKEFEELGOOD and MAKEFEELBAD] illustrate and identify Applicant's technique of counseling. They distinguish and separate his services from those of others. Each mark is a non-word: two verbs and an adjective combined and used as a noun. As such the marks form the basis of Applicant's unusual and incredibly simple technique of counseling.

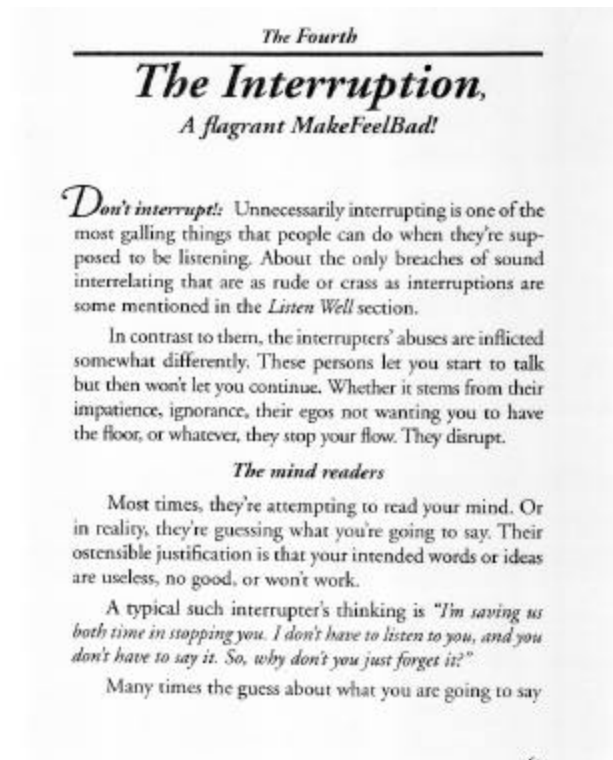
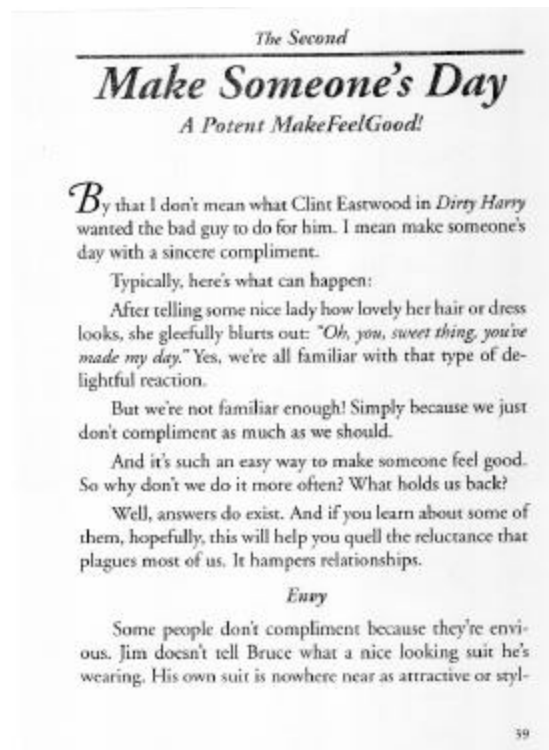
Simply put, throughout the counseling this question is posed: "Is the particular thing you are doing or saying in a relationship, a MakeFeelGood or a MakeFeelBad?" The point

is: Whether we render people close to us MakeFeelGoods or MakeFeelBads determines how we make them feel about themselves, good or bad. The result can affect a relationship positively or negatively. Thus, we need to ingrain practices that deal MakeFeelGoods and purge those that deal MakeFeelBads. That is the core of Applicant's counseling. And it pivots on the use of the two marks. They pinpoint, identify, and distinguish Applicant's counseling.

(Applicant's appeal brief, pp. 1 - 2).

Given the critical role of various specimens submitted by applicant during the course of prosecuting these applications, our determination of registrability herein is based upon a complete review of the ways in which applicant has used these alleged service marks.

Attached to the statements of use, both filed on January 25, 2001, were photocopies of two separate pages of applicant's book, entitled How to Improve Your Relationships, Dramatically: Methods that Really Work! The statements of use for MAKEFEELGOOD and MAKEFEELBAD were accompanied by page 39 and page 61, respectively, wherein the alleged service marks are used in the subtitles of Chapter 2 and Chapter 4, respectively, as follows:



During his examination of the Statements of Use, the Trademark Examining Attorney found these uses unacceptable for a variety of reasons. In response to the Office's refusal to register, applicant then submitted nine additional substitute specimens - copies of the same nine documents for both applications. In addition to a complete copy of applicant's paperback book, applicant also submitted catalogs having brief book reviews of applicant's book with order forms, an email exchange between applicant and a correspondent named "Jason," and a photocopy of a portion of what applicant claims to be his webpage. However, despite applicant's continuing objections, the Trademark Examining Attorney continued and made final his

earlier refusals based upon the fact that MAKEFEELGOOD and MAKEFEELBAD do not function as service marks for counseling services, and that none of the ten specimens in either file is acceptable to demonstrate service mark usage.

Applicant and the Trademark Examining Attorney have fully briefed these cases, but applicant did not request an oral hearing before the Board.

We affirm the refusals of registration.

Based upon this entire record, applicant is definitely involved in promoting a book that has been available in the marketplace since November 1999. Based upon a thorough reading of applicant's entire book, it is clear from applicant's own words that through this book, he is offering "theories," "methods," "concepts," "approaches," "measures," "practices," "techniques" (even "special techniques"), "tactics," "skills," "down-to-earth-practical suggestions," "counsel," "behaviors," "categories of actions," and "'do's,' 'don'ts,' and 'how-tos' of improving your relationships." According to the book, "yes" or positive action is identified as a "MakeFeelGood" (or "MakeFeelGoods," plural). A "no-no" or negative action is a "turnoff", or a "MakeFeelBad" (or "MakeFeelBads," plural). [For example, see discussion of "MakeFeelBad,"

pp. 55 - 56 of How to Improve Your Relationships,
Dramatically: Methods that Really Work!,].

Furthermore, in explaining the derivation of these two "inartful" "non-words," (applicant's description),³ applicant includes in the introductory matter the following paragraphs:

... That's the ball game. To help you win it, as mentioned, I cite many "dos," don'ts," and "how-tos." I put them in categories of: "make-feel-goods" and "make-feel-bads." And from a good-English perspective, these terms are anything but correct or artful.

Despite that, I use them prominently in headings of most sections. They serve a critical purpose. They tell you instantly why you should or should not do something.

This instant comprehension justifies their use. So, in pages that follow is a bundle of these "make-feel-goods" and "make-feel-bads."

And looking down from above, I hope Daniel Webster overlooks an even more grievous breach. From here on, I use these terms as one word without hyphens and quotation marks. Each will have a capital letter at the beginning of "make," "feel," and "good," or "bad." They will appear like this: MakeFeelBad or MakeFeelGood.

So please ignore the awkwardness and impropriety of these non-words. But learn their messages by heart. Then, implement them religiously in your relations with those important-to-you people. (pp. 22-23).

³ We agree with applicant that to the extent these run-together terms are not ordinary designations in the vernacular, they are certainly candidates for becoming valid source indicators. However, this case turns on exactly how these terms are actually used in advertising applicant's recited services.

[How to Improve Your Relationships, Dramatically: Methods that Really Work!, pp. 22 - 23].

Framework for our analysis

The function of a service mark is "to identify and distinguish the services of one person ... from the services of others and to indicate the source of the services" A mark is deemed to be in use on services "... when it is used or displayed in the sale or advertising of services and the services are rendered in commerce... ." As argued consistently by the Trademark Examining Attorney, the manner of use on the specimens must be such that potential purchasers would readily perceive the subject matter as identifying and distinguishing the applicant's services and indicating their source, even if that source is unknown. See Section 45 of the Trademark Act, 15 U.S.C. §1127, TMEP § 1301.04. Moreover, Section 1(d) of the Trademark Act, 15 U.S.C. §1051(d), requires that the owner of an intent-to-use application who has received a notice of allowance (e.g., as the instant applicant did in each of these applications) must then furnish the Office, within set timeframes, an actual specimen showing the mark as actually used.

Because service marks can be used in a great number of ways, the types of specimens that demonstrate the use of a service mark are numerous. However, there must be some direct association or nexus between the offer of services and the mark sought to be registered. In analyzing factually the acceptability of specimens of use, we have held that "while the nature of the services does not need to be specified in the specimens, there must be something which creates in the mind of the purchaser an association between the mark and the service activity." See In re Johnson Controls, Inc., 33 USPQ2d 1318 (TTAB 1994), citing to Intermed Communications Inc. v. Chaney, 191 USPQ 501 (TTAB 1977) and In re Metriplex, Inc. 23 USPQ2d 1315 (TTAB 1992). Hence, applicant must furnish specimens or facsimiles showing use of the mark in connection with the offering of the recited services. See also Trademark Rule 2.58, 37 C.F.R. §2.58.

Whether a mark has been used for a particular service is a question of fact to be determined primarily on the basis of the specimens. In re Advertising and Marketing Development Inc., 821 F.2d 614, 2 USPQ2d 2010 (Fed. Cir. 1987) [sets out "direct association test" between the mark sought to be registered and the services specified in the application; cases involving advertising services may

present factual considerations including whether the services are "sufficiently separate" from the subject of the advertising, and whether the mark has been used to identify the advertising services themselves]; In re Duratech Industries Inc., 13 USPQ2d 2052 (TTAB 1989) [the mere fact that the bumper stickers are distributed by organizations which perform the services did not persuade the Board that members of the general public who encounter the services would perceive the design on the bumper stickers as a mark identifying the services]; In re Moody's Investors Service Inc., 13 USPQ2d 2043 (TTAB 1989) ["Aaa" as used on the specimens, found to identify the applicant's ratings instead of its rating services]; In re El Torito Restaurant Inc., 9 USPQ2d 2002 (TTAB 1988) [no evidence of use of MACHO COMBOS for restaurant services where specimens showed use only to identify food items]; Peopleware Systems, Inc. v. Peopleware, Inc., 226 USPQ 320, 323 (TTAB 1985) [it is insufficient that a term alleged to constitute the mark be used in advertising, there must also be a direct association between the term and the services with respect to the advertising; use of the term PEOPLEWARE merely within a byline on calling card specimen did not constitute service mark usage of term, even though specimens elsewhere evidenced that applicant provided the

recited services]; see also Ready Communications v. Environmental Action Foundation, 477 F. Supp. 936, 203 USPQ 144 (D.D.C. 1979) [the mere advertising of one's goods does not constitute service mark use; use of the mark in technical bulletins and data sheets merely identified and advertised chemicals and not services].

We find that applicant's instant attempts to get federal trademark registrations for two designations used in connection with alleged services is reminiscent of reported decisions of this Board and our principal reviewing Court, dealing, for example, with terms for a concept, method or process where earlier applicants also thought their designations functioned as service marks. A concept, method or process, however, is only a way of doing something, and by itself is not an activity for the benefit of others:

While a designation used merely to identify a process does not perform the function of a service mark, a designation used to identify both a process and the services rendered in connection therewith constitutes a service mark within the meaning of the Trademark Act of 1946. See: In re Produits Chimiques Ugine Kuhlmann Societe Anonyme, 190 USPQ 305 (TTAB 1976), and cases cited therein. **The question of whether or not a term used as the name of a process also functions as a service mark must necessarily be resolved in a proceeding such as this by examining the specimens of record in the involved application, together with any other**

literature submitted by the applicant during the prosecution of the application, to determine the nature of the commercial impression which is created by the term as it is used by applicant. Cf. In re Produits Chimiques Uguine Kuhlmann Societe Anonyme, supra. Apropos thereto, the Court of Customs and Patent Appeals, in the case of In re Universal Oil Products Company, 177 USPQ 456 (CCPA 1973), has set forth the following guidelines to be considered in determining whether a term used as the name of a process also functions as a service mark:

"... The requirement [of the Statute] that a mark must be 'used in the sale or advertising of services' to be registered as a service mark is clear and specific. We think it is not met by evidence which only shows use of the mark as the name of a process and that the company is in the business of rendering services generally, even though the advertising of the services appears in the same brochure in which the name of the process is used. The minimum requirement is **some direct association between the offer of services and the mark sought to be registered therefore ...**" [emphasis supplied]."

In re J.F. Pritchard & Co., 201 USPQ 951, 952 (TTAB 1979) [proposed mark used only to identify liquefaction process, and not used in association with design and construction services]. Accordingly, terms that merely identify a concept, method or process are not registrable as service marks. As noted by our reviewing court in Universal Oil Products, the requirement is that there be a direct association between the applicant's offer of services and the proposed marks. See also In re Griffin Pollution Control Corp., 517 F.2d 1356, 186 USPQ 166 (CCPA 1975)

[alleged mark identifies a water treatment process but is not used as a mark]; and In re Hughes Aircraft Co., 222 USPQ 263 (TTAB 1984) [specimens and other material offered by the applicant showed mark used only in connection with a photochemical process or method, with no association between the applicant's offer of services and the mark].

Applicant argues strenuously that his targeted customers would perceive the terms MAKEFEELGOOD and MAKEFEELBAD, as shown in the pages of his book, to be source indicators for the recited services. We disagree. Nowhere do the uses of these terms in the book show the terms MAKEFEELGOOD and MAKEFEELBAD being used as service marks. There is no language that makes either a direct or an indirect association between the terms MAKEFEELGOOD and MAKEFEELBAD and applicant's counseling services. The Trademark Examining Attorney has made the argument most forcefully that these files reflect a total absence of any association or nexus between the marks and the alleged services.

As to applicant's book itself, this record does not show how popular this book has been. For our purposes herein, it seems irrelevant whether this is a vanity book without any substantial readership, or contrariwise, is

poised to eclipse Dale Carnegie's famous 1936 book on relationships, How to Win Friends and Influence People, as applicant's publisher suggests. However, even if we were to hypothesize that the concepts MAKEFEELGOOD and MAKEFEELBAD are universally and unquestionably identified in some way with Mr. Loomis, that does not mean the terms function as service marks for the services that applicant has recited herein. Applicant's wishes or intentions will not magically turn these terms into source identifiers. Cf. In re Port-A-Hut, Inc., 183 USPQ 680, 682 (TTAB 1974).

Does the file reflect applicant offering any services?

It is abundantly clear from this record that applicant is attempting to promote his book. It is clear from the contents of the entire book that MAKEFEELGOOD and MAKEFEELBAD are recurring concepts in the pages of this book. However, we agree with the Trademark Examining Attorney that the dozens of repetitions of both of these designations throughout the book do not show use of the mark for applicant's recited counseling services.

On the other hand, the Trademark Examining Attorney seems to acknowledge from the recital of services alone that applicant is actually providing counseling services. (Trademark Examining Attorney's appeal brief, p. 4).

Hence, he does not tackle directly the question of 'whether all the activities of promoting a self-help book can actually be seen as providing "counseling" services?'⁴ As a result, it appears that many of the seemingly hyper-technical objections raised by the Trademark Examining Attorney (and derided by applicant in his brief) grow out of a reality that the majority of the specimens of record have absolutely nothing to do with rendering professional "counseling" as that activity is traditionally understood - within the U.S. Trademark Office or without.⁵

In fact, applicant (the book's author) makes this point most dramatically in the frontispiece of the book:

This book is designed to educate and inform based on the author's experiences. It is sold with the understanding that the publisher and author are not rendering professional services or counsel. If professional guidance is needed, a competent professional should be engaged.

Specimens unacceptable

In issuing his final refusal, the Trademark Examining Attorney continued to charge that none of the specimens of

⁴ Although the Trademark Examining Attorney does say rather clearly in his appeal brief: "Books don't give counsel; people do. Applicant is merely a salesman..." (Trademark Examining Attorney's appeal brief, p. 9).

⁵ The only possible exception is an email exchange discussed below.

record shows use of the mark in connection with applicant's offering the claimed counseling services to potential customers.

Accordingly, to determine whether applicant's alleged service mark has been used in connection with the recited services, we take a comprehensive look at all of the specimens of record.⁶

As noted by the Trademark Examining Attorney, applicant's two invoices (Exhibits 1A and 1C), a third party's purchase order (Exhibits 1B) and an order form from Amazon.com (Exhibits 1D) refer to the title of applicant's book. However, the involved designations applicant claims as service marks are nowhere displayed on these documents.

Furthermore, Exhibits 3 through 9 are nothing more than Publishers Marketing Association brochures directed to book buyers, book reviewers and librarians. In addition to the fact that these potential readers are getting applicant's book free-of-charge for the asking, such catalogs cannot logically show use of a designation as a service mark for counseling services - even if the target audience were paying list price for the book. These seven nearly-identical entries that applicant has highlighted

⁶ Substitute specimen #1 is the copy of applicant's entire book, which has been discussed at length above.

from each review contain the terms MAKEFEELGOOD(S) and MAKEFEELBAD(S). However, viewed for what they are, they represent tertiary sources, at best, making non-service mark references to applicant's methodology.

That leaves us with Exhibits 2A, 2B and 10.⁷ Given what they purport to show, this exchange represents the closest activity to counseling found within these records. However, as noted by the Trademark Examining Attorney, they also present a myriad of problems for applicant. First, Exhibit 10 is nothing more than two sentences printed across the middle of a single 8½" x 11" piece of plain, white bond paper. Inasmuch as it is not a screen print of applicant's Internet homepage (e.g., lacking URL's, dates of printing, etc.), it stands as evidence of nothing. Exhibit 2A is a photocopy of an email sent to applicant from one "Jason" responding to applicant's webpage instructions to "Ask the Author." In outlining his severe interpersonal problems, Jason dutifully complies with the letter of applicant's request that any query for the author

⁷ In his response of November 1, 2001, applicant refers to the following edited portion of his homepage as "Exhibit 8." However, it seems to have been marked by applicant as "Exhibit 10" and has been so nominated by the Trademark Examining Attorney throughout the prosecution of these applications:

MakeFeelGoods: What are they?: They are things that you do or say that make others feel good about themselves. A MakeFeelGood buoys self esteem.
MakeFeelBads: What are they?: They are things that you do or say that make others feel bad about themselves. A MakeFeelBad decimates self esteem.

"must relate to *MakeFeelGoods* and *MakeFeelBads*." However, it is quite clear from our earlier, extensive review of the minimum requirements for service mark specimens that an email note drafted by a troubled teen does not constitute service mark usage by applicant. Furthermore, applicant's reply to Jason (Exhibit 2B) is an email response plugging the book while reciting by-now familiar references to applicant's two distinct bundles of behaviors.

We should note in closing that the Trademark Examining Attorney, in these two applications, also raises other problems with the specimens of record. While he is correct with regard to these other informalities, in light of our disposition of these two applications based upon a review of the most serious failures of the uses in the records, we have chosen not to discuss at length these other weaknesses of applicant's proffered service mark specimens.⁸

⁸ As to "Issue 2" in the Trademark Examining Attorney's appeal brief, we agree that these terms are presented in a narrative context as part of a larger thought. Within a book of 160 pages, even the chapter subtitles are overshadowed by the book title, etc. See *In re European-American Bank & Trust Company*, 201 USPQ 788 (TTAB 1979) [banking slogan THINK ABOUT IT not registrable]; *In re Wakefern Food Corp.*, 222 USPQ 76 (TTAB 1984) [WHY PAY MORE! does not function as a service mark]; *In re Melville Corporation*, 228 USPQ 970 (TTAB 1986) [BRAND NAMES FOR LESS unregistrable for retail clothing store services]; *In re Mautz Paint & Varnish Company*, 157 USPQ 637 (TTAB 1968) ["PAINTING ... ask the EXPERT the man in the ORANGE JACKET!" found to be unregistrable for paints and similar coverings]; and *In re Gilbert Eiseman, P.C.*, 220 USPQ 89 (TTAB 1983) [Designation IN ONE DAY not registrable as a service mark for plastic surgery services].

In summary, given the absence in these records of any nexus between the terms MAKEFEELGOOD and MAKEFEELBAD and the recited services, we affirm the refusal of the Trademark Examining Attorney as to registration of these marks for applicant's recited counseling services. Furthermore, the refusal to register is affirmed on the ground that the specimens of record are not acceptable evidence of actual service mark usage of the terms MAKEFEELGOOD and MAKEFEELBAD.

Decision: The refusals to register are affirmed.

As to "Issue 5" in the Trademark Examining Attorney's appeal brief, we agree that if these designations truly functioned as service marks, applicant should decide whether the marks are MAKEFEELGOOD and MAKEFEELBAD (singular) or MAKEFEELGOODS and MAKEFEELBADS (plural). Given the importance of consistent "brand identity," a trademark owner risks the diminution of a valid source-indicator (an adjective) with careless uses of the pluralized or possessive forms of the chosen designation(s).

Finally, we feel compelled to volunteer the following in response to a related point discussed several times by applicant. Specifically, in the event that applicant believes the commercial impression of his marks would be protected best by using a telescoped format while retaining a presentation having a mix of upper- and lower-case letters, he certainly retains the option (whether filing applications electronically or via the traditional paper route) of preparing for the Office "special form drawings" of these designations [e.g., depicting the marks as MakeFeelGood (rather than the typed drawing of MAKEFEELGOOD) and MakeFeelBad (rather than the typed drawing of MAKEFEELBAD)].